

Amendments to the claims are made, hereby, in order to more clearly define the instant invention.

Applicant wishes to thank Examiner L. Crane for the courteous consideration extended to applicant's representative during an interview at the USPTO on September 4, 1997. During the interview, all rejections of record were discussed. The resolution of certain § 112 matters referred to in the examiner's Interview are, in some instances, reflected in the changes made to the claims by the instant amendment. Other instances of the resolved matters are reflected in the following arguments and explanations addressing the issues raised by the present Office action.

The present Office action contains rejections under §101, §112, second paragraph, §112, first paragraph, and §103. Reconsideration is respectfully requested.

The §101 rejection alleges that use of the term "using" in the claims is improper. The issue was resolved during the interview; by changing "using" to --by applying--. Applicant considers that "using" was appropriate. The claims recited "using" as part of a limitation in a "process" (as opposed to a use-type claim); a claim to a "method" that recites the limitation "**which comprises utilizing the nozzle**" was held to be proper, and the examiner's rejection based on the term "utilizing" was reversed, by the PTO Board

of Appeals in the case of Ex parte Porter, 25 USPQ2d 1144 (BPAI 1992). Furthermore, the USPTO has, specifically, recognized that "utilizing" is acceptable claim language. MPEP 2173.05(q).

The rejection under §112, second paragraph, is based on reciting "in particular, plasmid, or genomic DNA" being allegedly indefinite. As resolved during the interview, the language considered indefinite by the examiner is deleted from the claim and made part of a new dependent claim.

As for the examiner's objection to "high surface charge," claim 69 is canceled, rendering the matter moot.

The allegation that the subject matter of claim 64 lacks antecedent basis in claim 62 was resolved during the interview. Accordingly, claim 64 now reads --further comprising the step of . . . ."

Objection to the term "or a combination thereof" is rendered moot by the present amendment, which cancels the language considered objectionable.

The § 112, 2<sup>nd</sup> paragraph, rejection of the terms "includes" and "comprises" for allegedly creating improper claim breadth (i.e., "failure to further define the implied missing components") is unsupported by any reference to a statute, rule, regulation, or controlling case law. Applicant is free to be his own lexicographer. In re Castaing, 166 USPQ 550 (CCPA 1970). In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989). It is the applicant's prerogative to define the claims, not the examiner's. In re Pilkington, 162

USPQ 145 (CCPA 1969). Furthermore, the allegation would not support a rejection for indefinite claim language (§ 112, 2<sup>nd</sup> paragraph) even if it were true; claim "breadth is not to be equated with indefiniteness." In re Miller, 169 USPQ 597 (CCPA 1970). Applicant respectfully submits that these terms are used appropriately in the context of the instant claims.

The objections to examples 3 and 4 of the specification (action page 4, lines 15-22) were resolved during the interview upon careful inspection these examples. The phrase "[a]ccording to example 3" means the same as according to the present example. In Example 4, "erythrocytes" are subjected to "lysis," while "leukocytes" comprise the "whole cells" that are subsequently treated in accordance with the presently claimed "process".

The rejection under §103 for alleged obviousness is based on the combined teachings of Henco '426 and Little '430. The statement of rejection uses essentially the same arguments found in the rejections made in the parent application; except that the Hagen and Sternberg references are not cited to support the instant rejection.

Applicant respectfully submits the statement of rejection takes out of context certain statements made in Little; which distorts what is, actually, described and disclosed by the reference. That is, Little states "the invention is directed generally to the immobilization of DNA onto diatomaceous earth which comprises contacting the DNA with the diatomaceous earth in the presence of a chaotropic agent" (Little column

2, lines 32-35). Similar statements are made, elsewhere, in the reference. The statement of rejection characterizes these references in a manner that makes it appear as if Little encompasses (that is, contemplated) using isolated DNA as a starting material.

On the contrary, Little was concerned with the desire "to rapidly and inexpensively separate and purify DNA that was also amenable to scale-up" (Little column 1, lines 66-67). Little contemplated purifying DNA from "bacterial lysates" (Little column 1, lines 11-12); "plasmid DNA from mini-prep lysates can be purified using the process of the present invention" (Little column 5, lines 43-44), "this example illustrates that DNA can be purified from bacterial lysates independently of the method used to prepare the DNA and without prior phenol extraction to remove proteins" (Little, example 1) "the isolation of supercoiled DNA from an agarose gel by binding onto diatomaceous earth" (Little example 4), "nucleoside from triphosphates are effectively removed from radiolabeling reactions by the process of the present invention" (Little example 5), "the removal of linkers from cloning reactions using the process of the present invention" (Little example 6). Accordingly, Little contemplated, and described, a process that would address the problem whereby the "purification of plasmid DNA from bacterial lysates is a rate-limiting and time-consuming step in molecular biology"

(Little column 1, lines 11-13), and fulfilled the objective whereby "a method was still desired to rapidly and inexpensively separate and purify DNA that was also amenable to scale-up" (Little column 1, lines 66-68).

As a result, the desirability (that is, motivation) provided by Little was to develop a process for isolated and purifying DNA that was more rapid than known methods. This motivation would not have led one of ordinary skill in the art to combine Little with Henco since it would not have sped up the process of either Little or Henco, at all; in fact, it would have increased the time over and above that needed to perform either the Henco process or the Little process. If there were any motivation, it would have been to replace the Henco method, entirely, with the Little method; which, also, would have effected the optional desalting step taught by Henco.

With all due respect, the rejection uses impermissible hindsight; that is, by selectively picking and choosing from Little's teachings in a manner that fails to appreciate Little, as a whole.

Furthermore, as pointed out during the interview, the suggested combination would destroy the invention upon which Little was based; that is, for example, a one-step procedure to save time. A reference cannot be used (under § 103) to show obviousness in a manner that destroys the invention on which the reference is based.

In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984).

Favorable action commensurate with the foregoing is requested.

Respectfully submitted,

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